

## **REMARKS**

Presently claims 1, 2, 4-6, 8-9, and 11-24 are pending in this application, with claims 3, 7, and 10 having been previously cancelled. Claims 1 and 9 have been amended with this Response. Applicant will now respectfully address the examiner's objections and rejections in turn.

### Rejections under 35 U.S.C. 103(a)

Claims 1, 2, 4-6, 9, 11, 12, and 19-24 are rejected under 103(a) as being obvious over United States Patent No. 5,355,988 to Shirasawa ("Shirasawa" hereinafter) in view of United States Patent No. 5,111,860 to Wingate-Hill ("Wingate" hereinafter). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

In addition, according to 2141.01(a), "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." *structural similarity* (*In re Bigio*, 381 F.3d 1320, 1325-26, 72 USPQ2d 1209, 1211-12 (Fed. Cir. 2004) is the determining factor in the mechanical arts.

Applicant first points out that the Wingate apparatus is in a field (debarking logs) different from that of Applicant's endeavor (separating coins), and "the matter with which [Wingate] deals" does *not* logically commend itself to the problem addressed by Applicant's disclosure. The matter with which Wingate deals is improving compression debarking equipment. The logs to be debarked by the Wingate equipment are singularized prior to being supplied to the equipment. As such, the Wingate in no way "deals with" or implies singularizing of logs or any other items.

Contrary to Wingate, both Shirasawa and an exemplary apparatus/method protected by Applicant's claims deal almost exclusively with the problem of separating coins. As such, the matter with which Wingate deals (i.e. stripping/debarking of an object/log) certainly does not logically lend itself to the problem addressed by the field of endeavor or Application for Patent (i.e. separating a plurality of items/coins). In other words, stripping a single item of an outer layer does not logically lend itself to a problem/invention directed to separating one item from a plurality of items.

Furthermore, and also under MPEP 2141.01(a) IV, *structural similarity* (*In re Bigio*, 381 F.3d 1320, 1325-26, 72 USPQ2d 1209, 1211-12 (Fed. Cir. 2004) is the determining factor in the mechanical arts.

The most critical element in separating coins (as disclosed in Applicant's claims and Shirasawa) and debarking logs (Wingate) is the aperture through which the coins and logs are respectively passed. It is at this aperture where the separating or debarking occurs, and, as shown in the references, the aperture directed to separating is very different from the aperture for debarking. Referring to column 3, line 34 of Wingate, the rollers are disposed to define a *hexagonal* aperture that best facilitates bark stripping. On the contrary, both the Shirasawa device and an exemplary apparatus/method protected by Applicant's claims include rollers that define substantially *rectangular* apertures that best facilitate separating one coin from multiple coins. This structural difference provides mechanical art evidence of the different matters to be dealt with in these references.

Applicant further notes that Shirasawa and Wingate belong to different Patent Office classifications, which offers ‘some evidence of "nonanalogy."’ While such a classification difference is not controlling, taken in combination with the above discussion, these differences provide further evidence of non-analogy.

Applicant still further notes that the ability of the Wingate rollers to rotate in the same direction at different speeds is mentioned only once as nothing more than an aside in the Wingate patent. This reference is likely made in such an off-hand manner because this alleged ability is not well thought out in Wingate, and actually detrimental to the Wingate process.

Referring to rollers rotating in the same direction, Wingate requires a log-by-log supply to the device (column 3, lines 55 to 66). Since the rollers have to be driven to propel a log through the equipment, there is no roller of the triple of rollers that rotates in a direction contrary to movement of the log through the equipment. All rollers of triple of rollers therefore have to be rotated so that each of the rollers can support the movement of the log, and rotate the log in a single direction through the device. Since the rollers are actually pressed to (in a manner that grips) the log (column 3, lines 55 to 57), any rotation contrary to log movement in a single direction would obviously deter movement of the log in that direction. In other words, referring to Figure 1f<sup>o</sup> of Wingate, *if the roller on the far right and the roller on the far left were to rotate in the same direction (for example clockwise), the roller on the far right would effectively attempt to move the log to the right and the roller on the far left would effectively attempt to move the log to the left.* As such, despite Wingate’s mention of rollers moving in the same direction, the device of Wingate would fail from a technical perspective to move the log through the system if this mention were actually practiced in operation of the equipment.

Referring now to rollers rotating at different speeds, the triple of rollers of Wingate require the same rotational speed of each of the rollers because the speed of the rollers *is determined by the movement of the log through the equipment.* This is necessary because the rollers are pressed to (i.e. grip) the log (column 3, lines 55 to 57). As such, despite

Wingate's mention of rollers moving at different speed, such movement, from a technical perspective, is in contrast to operation of the Wingate equipment.

Accordingly, Wingate does not teach rotating the rollers in a same direction at different speeds, as is required by Applicant's claims. Since the Examiner concedes that Shirasawa also does not teach rotating the rollers in a same direction at different speeds, Applicant respectfully asserts that the proposed combination of Wingate and Shirasawa does not teach rotating the rollers in a same direction at different speeds.

With reference to the above claim amendments, Applicant respectfully notes that claims 1 and 9 have been amended to recite, *inter alia*,

“rotating the rollers in a same direction at different speeds about substantially parallel axes of rotation.”

As mentioned above, the Examiner concedes that Shirasawa also does not teach rotating the rollers in a same direction at different speeds. As such, Shirasawa certainly does not teach rotating the rollers in a same direction at different speeds about substantially parallel axes of rotation. If, *pro arguendo*, the Examiner were to continue to allege that Wingate remedies the deficiency of Shirasawa relating to rotating the rollers in a same direction at different speeds (which it respectfully does not), Applicant would respectfully assert that Wingate does not teach rotating the rollers in a same direction at different speeds about substantially parallel axes of rotation. On the contrary, referring to Figures 1f, 1f', and 3 in particular, Wingate clearly teaches rollers that do not include substantially parallel axes of rotation.

Lastly, with reference to the Examiner's note regarding MPEP 2115, Applicant respectfully points out that this section of the MPEP only applies to cases “limited to claims directed to machinery which **works upon** an article or material in its intended use,” wherein the supporting case law is directed to **making concrete beams** (*In re Young*) and **forming a brush** (*In re Casey*).” (emphasis added). Applicant respectfully submits that the limitations regarding aperture spacing in relation to coins size found in claim 9 is not

analogous to a limitation directed to working on, making, or forming an article via claimed machinery as discussed in MPEP 2115. On the contrary, Applicant's limitation offers a concrete structural limitation in the apparatus claim, wherein this limitation is very similar to limitations found in claim 1 of Shirasawa. Furthermore, since claim 1 is a method claim, MPEP 2115 clearly does not apply thereto.

For at least the above reasons, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 1, 2, 4-6, 9, 11, 12, and 19-24 with respect to the proposed combination of Shirasawa and wingate

Claims 8, 13, and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Shirasawa in view of Wingate and United States Patent No. 5,988,349 to Bruner ("Bruner" hereinafter). Applicant respectfully traverses, with claim 7 having been respectfully cancelled.

With reference to the arguments above, Applicant respectfully points out that there is no motivation to combine Shirasawa and Wingate. As Bruner does not remedy the deficiencies of Shirasawa, and claims 8, 13, and 18 depend variously from claims 1 and 9, the proposed combination of Shirasawa and Bruner, with or without Wingate, does not teach every element of claims 8, 13, and 18. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 8, 13, and 19 with respect to the proposed combination of Shirasawa, Wingate, and Bruner.

Claims 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being obvious over Shirasawa in view of Wingate and United States Patent No. 5,713,451 to Masse ("Masse" hereinafter). Applicant respectfully traverses.

With reference to the arguments above, Applicant respectfully points out that there is no motivation to combine Shirasawa and Wingate. As Masse does not remedy the deficiencies of Shirasawa, and claims 14, 16, and 17 depend from

claim 9, the proposed combination of Shirasawa and Masse, with or without Wingate, does not teach every element of claims 14, 16, and 17. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 14, 16, and 17 with respect to the proposed combination of Shirasawa, Wingate, and Masse.

Claim 15 is rejected under 35 U.S.C. 103(a) as being obvious over Shirasawa, in view of Masse, Wingate, and United States Publication No. 2003/0127299 to Jones (“Jones” hereinafter). Applicant respectfully traverses.

With reference to the arguments above, Applicant respectfully points out that there is no motivation to combine Shirasawa and Wingate. As neither Masse nor Jones remedies the deficiencies of Shirasawa, and claim 15 depends from claim 9, the proposed combination of Shirasawa, Masse, and Jones, with or without Wingate, does not teach every element of claim 15. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claim 15 with respect to the proposed combination of Shirasawa, Wingate, Masse, and Jones.

Conclusion

All of the objections and rejections are herein overcome. In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. No new matter is added by way of the present Amendments and Remarks, as support is found throughout the original filed specification, claims and drawings. Prompt issuance of Notice of Allowance is respectfully requested.

The Examiner is invited to contact Applicant's attorney at the below listed phone number regarding this response or otherwise concerning the present application.

Applicant hereby petitions for any extension of time under 37 C.F.R. 1.136(a) or 1.136(b) that may be necessary for entry and consideration of the present Reply.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,

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